

REMARKS

Status of the Claims

Claim 7 is pending in the present application. Claim 7 is amended herein to convert a product-by-process limitation into an explicit step. Thus, no new matter has been added.

Applicants submit that the present amendment reduces the number of issues under consideration and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claim.

Issues under 35 U.S.C. § 103(a)

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schauder et al. '766 (US 5,728,766) in view of Singha et al. (Journal of Applied Polymer Science) (pages 2-6 of the outstanding Office Action and page 2 of the Advisory Action).

Applicants respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited References

Independent claim 7 recites the step of “hydrogenating natural polyisoprenoid latices in the state of latex to obtain a hydrogenated natural polyisoprenoid” (emphasis added). As the Examiner admits, the cited references fail to disclose this element.

However, the Examiner asserts that this claim is a product-by-process claim (page 4, first full paragraph of the outstanding Office Action). In the Advisory Action, the Examiner states, “Although the claim as a whole is a method claim, the limitations with regard to the process of making the starting material is written in a product by process format.... Absent an explicit step of preparing the polymer in the claimed method, the limitations on its production are being treated as a product by process limitation.”

In response, claim 7 is amended herein to recite the step of preparing the polymer explicitly. As such, the step of “hydrogenating natural polyisoprenoid latices in the state of latex to obtain a hydrogenated natural polyisoprenoid” should be fully considered.

Schauder et al. ‘766 teach a rubber-like article comprising an ethylene-propylene copolymer that has been molded and vulcanized. Schauder et al. ‘766 teach that the copolymer has a molecular weight distribution between 1 and 8. However, Schauder et al. ‘766 fail to teach the step of subjecting a rubber composition comprising a hydrogenated natural polyisoprenoid to molding/forming accompanied by vulcanization. Furthermore, Schauder et al. ‘766 do not teach the step of “hydrogenating natural polyisoprenoid latices in the state of latex to obtain a hydrogenated natural polyisoprenoid.”

Singha et al. teach hydrogenating a natural rubber/*Hevea brasiliensis* to a degree of hydrogenation of 100% in the presence of a rhodium complex in a solvent. However, Singha et al. do not teach the claimed process step comprising a hydrogenated natural polyisoprenoid. Furthermore, Singha et al. do not teach the step of “hydrogenating natural polyisoprenoid latices in the state of latex to obtain a hydrogenated natural polyisoprenoid” (emphasis added).

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Schauder et al. '766 in view of Singha et al. fail to disclose all of the claim limitations of independent claim 7. Accordingly, the combination of references does not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

Conclusion

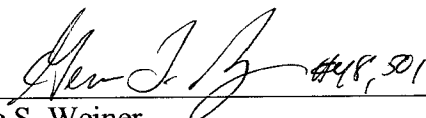
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. A complete response has been made to the outstanding Office Action, and as such, the application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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